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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,356	01/23/2002	Fatollah Youssefifar	20272/0700	3388

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EXAMINER

DUNWOODY, AARON M

ART UNIT PAPER NUMBER

3679

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,356

Applicant(s)

YOUSSEFIFAR, FATOLLAH

Examiner

Aaron M. Dunwoody

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/25/2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5406983, Chambers et al.

In regards to claim 1, Chambers et al discloses a coupling for a pipe, the coupling comprising a housing (12) of a relatively rigid plastics material, the housing having a bore therein; a retainer (28) arranged to retain the pipe within the housing when the pipe is pushed into the housing; and a layer of a relatively deformable material (26) molded onto at least a part of both an inner and outer surface of the housing wherein the layer on the inner surface being is in sealing engagement with an outside of the pipe.

Note, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976). Therefore, a layer of a relatively deformable material **molded** onto at least a part of both an inner and outer surface of the housing is given little patentable weight.

In regards to claim 3, Chambers et al discloses the layer on the inner surface providing a tapering surface.

In regards to claim 4, Chambers et al discloses the retainer being formed integrally with the housing.

In regards to claim 5, Chambers et al discloses the retainer including at least one resilient catch member adapted to engage a projection on the pipe.

In regards to claim 7, Chambers et al discloses the layer on the outer surface including a part (above 16) formed on external ledge of the housing to provide a seal with a cooperating member (a hand).

In regards to claim 8, Chambers et al discloses the layer on the outer surface including a part (above 16) that provides a manual gripping region.

In regards to claim 9, Chambers et al discloses the layer on the inner and outer surfaces being continuous with one another.

In regards to claim 10, Chambers et al discloses the deformable material being an elastomeric material.

In regards to claim 13, Chambers et al discloses a method of forming a coupling comprising the steps of injecting a first material of a relatively hard plastics material to form a housing of the coupling with an integral retainer; and subsequently injecting a second, softer, deformable material to form a layer on the harder material both on an inside and outside of the housing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4923227, Petty et al in view of Chambers et al.

In regards to claim 1, Petty et al discloses a coupling for a pipe, the coupling comprising a housing (1) of a relatively rigid plastics material, the housing having a bore therein; and a retainer (9) arranged to retain the pipe within the housing. Petty et al does not disclose a layer of a relatively deformable material molded onto at least a part of both an inner and outer surface of the housing when the pipe is pushed into the housing. Chambers et al teaches a layer of a relatively deformable material (26)

molded onto at least a part of both an inner and outer surface of the housing (12) "to provide a coupling which is both corrosion resistant and capable of providing good sealing characteristics" (col. 3, lines 20-23). As Chambers et al relates to tubular members for use with pipes to corrosion-resistant couplings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a layer of a relatively deformable material molded onto at least a part of both an inner and outer surface of the housing to provide a coupling which is both corrosion resistant and capable of providing good sealing characteristics, as taught by Chambers et al.

In regards to claim 3, Chambers et al discloses the layer on the inner surface providing a tapering surface.

In regards to claim 4, Petty et al discloses the retainer being formed integrally with the housing.

In regards to claim 5, Petty et al discloses the retainer including at least one resilient catch member adapted to engage a projection on the pipe.

In regards to claim 6, Petty et al discloses the pipe having a corrugated external surface, and wherein the catch member is adapted to engage between the corrugations.

In regards to claim 7, Chambers et al discloses the layer on the outer surface including a part formed on external ledge of the housing to provide a seal with a cooperating member.

In regards to claim 8, Chambers et al discloses the layer on the outer surface including a part that provides a manual gripping region.

In regards to claim 9, Chambers et al the layer on the inner and outer surfaces being continuous with one another.

In regards to claim 10, Chambers et al the deformable material being an elastomeric material.

In regards to claim 11, Petty et al in view of Chambers discloses a coupling for connecting one end of a corrugated pipe to a cooperating member, the coupling comprising a rigid housing of tubular shape having two spring catches on opposite sides arranged to engage between corrugations on an outside of the pipe when the pipe is pushed into the coupling; and a continuous layer of a deformable material bonded with both an inside and outside of the housing to form an internal, tapering sealing surface adapted to seal with an outside of the pipe, an external annular sealing member, adapted to seal with the cooperating member, and an external gripping region.

In regards to claim 12, Petty et al in view of Chambers et al an assembly of a corrugated pipe and a coupling, the coupling comprising a housing of a relatively rigid plastics material, the housing having a bore therein; retaining means arranged to retain the pipe with the housing when the pipe is pushed within the coupling; and a layer of a relatively deformable material molded onto at least a part of both an inner and outer surface of the housing, wherein the layer on the inside surface forms a seal with an outside surface of the pipe in the bore.

In regards to claim 13, Chambers et al discloses a method of forming a coupling comprising the steps of injecting a first material of a relatively hard plastics material to form a housing of the coupling with an integral retainer; and subsequently injecting a

second, softer, deformable material to form a layer on the harder material both on an inside and outside of the housing when the pipe is pushed into the housing.

In regards to claim 14, Petty et al discloses the retainer including at least one resilient catch member adapted to engage a projection on the pipe.

In regards to claim 15, Petty et al discloses the retainer including at least one resilient catch member adapted to engage a projection on the pipe.

In regards to claim 16, Petty et al discloses the retainer including at least one resilient catch member adapted to engage a projection on the pipe.

Response to Arguments

Applicant's arguments filed 7/25/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Chambers et al teach a retainer arranged to retain the pipe within the housing when the pipe is pushed in the housing, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

The Applicant argues:

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The retainer of Chambers et al. is a screw thread and therefore is not able to retain a pipe that is pushed into the housing or pushed within the coupling as recited in amended independent claims 1 and 13.

The Examiner disagrees. In Figure 1, Chambers et al. illustrates a tapered thread bore, in order to make a threaded connection with the retainer, a pipe must be pushed into the housing or pushed within the coupling as recited in amended independent claims 1 and 13.

The Applicant argues:

...the Examiner has identified element 12 of Chambers et al. as being a housing of relatively rigid plastics material. However, item 12 is a stress bearing sleeve, and is preferably made of steel, iron, aluminum or high performance composites of glass or ceramic.

The Examiner disagrees. Chambers et al recites:

Materials contemplated for use in forming stress-bearing sleeve member 12 include steel, iron, aluminum and other metal for this purpose and, in addition, high performance composites. (col. 5, lines 34-37)

Commonly known in the art, high performance composites include rigid plastics materials; therefore, Chambers et al. met the claim limitation.

The Applicant argues:

...the Examiner has referred to the composite shell (26) of Chambers et al. as being equivalent to the claimed deformed material that forms a seal with a conduit. However, the shell (26) is clearly not deformable, especially not to such an extent as to provide any form of sealing... Such a material [of Chambers et al.] could not fairly be considered to be

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deformable due to the harsh environment in which it is adapted to function, and due to the fact that it must support a thread.

The Examiner disagrees. Chambers et al recites :

It is yet another objective of the present invention to provide a coupling which is both corrosion resistant and capable of providing good sealing characteristics. (col. 3, lines 20-23)

Therefore, Chamber et al. and Petty et al. meet the claim limitation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it illustrates the inventive concept of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody
Primary Examiner
Art Unit 3679

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